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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,068	10/25/2001	Richard B. Streeter	VIA-13	6713

7590 05/19/2005  
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EXAMINER

BLANCO, JAVIER G

ART UNIT PAPER NUMBER

3738

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/004,068

Applicant(s)

STREETER, RICHARD B.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 12, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 6, 2005 has been entered.

### ***Response to Amendment***

2. Applicant's cancellation of claims 7-11 and 13-17 in the reply filed on May 6, 2005 is acknowledged.

3. Applicant's amendment of claims 1-6, 18, and 19 in the reply filed on May 6, 2005 is acknowledged.

### ***Claim Objections***

4. Claims 1, 4, 6, 12, and 18 are objected to because of the following informalities:

a. Regarding claim 1, please add --shaped-- in front of "sheet" (see line 4). Appropriate correction is required.

b. Regarding claim 4, please add --shaped-- in front of "sheet" (see line 2). Appropriate correction is required.

c. Regarding claim 6, please add --shaped-- in front of "sheet" (see line 2). Appropriate correction is required.

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d. Regarding claim 12, please add --shaped sheet of-- in front of "material" (see line 2).

Appropriate correction is required.

e. Regarding claim 18, please add --and an annulus,-- in front of "the method" (see line 2).

Appropriate correction is required.

f. Regarding claim 18, please add --surface-- in front of "configuration" (see line 5). Appropriate correction is required.

g. Regarding claim 18, please (i) add --edge of the-- in front of "shaped" (see line 15), and (ii) delete "edge" (see line 15, third occurrence). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-5, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 3, "the shaped sheet of material total surface configuration" (see lines 2-3) lacks antecedent basis.

b. Regarding claim 4, "the total surface area of the sheet of material" (see line 2) lacks antecedent basis.

c. Regarding claim 5, "the total surface area of the sheet of material" (see line 2) lacks antecedent basis.

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- d. Regarding claim 18, the limitation “substantially matching substantially” (see line 6) is vague and confusing, rendering claim 18 indefinite. Perhaps the limitation should be rephrased to read -substantially matching the entirety--. Claim 19 depends on claim 18.
- e. Regarding claim 18, “the substantial entirety” (see line 2) lacks antecedent basis. Will it be more accurate to rephrase said limitation to read --the shield substantially overlies the entirety of the--? Claim 19 depends on claim 18.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-6 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Gabbay (US 6,419,695 B1).

Referring to Figures 1-12 (particularly Figures 5 and 6), Gabbay discloses a valve shield (apparatus 150) comprising a substantially crescent-shaped sheet of material (Figure 6: see crescent-shaped area of buttress 164) *structured for affixing* (emphasis added to functional language) to an annulus of a cardiac valve having first and second leaflets (see column 5, lines 38-41), said shaped sheet of material having a surface area and a surface configuration substantially matching a substantially total surface area and a substantially total surface configuration of the first leaflet of the valve (see column 5, lines 13-33), and shaped

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complementarily to the second leaflet so as to be substantially wholly *contactable* (emphasis added to functional language) by an edge portion of the second leaflet of the valve (see column 5, lines 13-33), whereby *to facilitate* (emphasis added to functional language) inter-engagement of the second leaflet edge portion and an edge portion of the shaped sheet of material to effect closing of the valve (see entire document).

Claim 1 is an apparatus claim. The intended use recitations (e.g., “for affixing”, “contactable”, “to facilitate”, “capable of”, etc.) carry no patentable weight in the absence of any distinguishing structure. Gabbay discloses the structure (and intended use) as claimed and is found to be inherently capable of performing the function.

a. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959).

“[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

### ***Response to Arguments***

9. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

10. Claim 18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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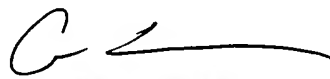
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

May 13, 2005



CORRINE McDERMOTT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700